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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/584,447	07/09/2007	Tomosaki Takakura	0032-0291PUS1	4157
2292 7590 08/20/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				
EXAMINER				
EPFS -SMITH, JANET L				
ART UNIT		PAPER NUMBER		
1633				
NOTIFICATION DATE		DELIVERY MODE		
08/20/2010		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/584,447

Applicant(s)

TAKAKURA ET AL.

Examiner

Janet L. Epps-Smith

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 02 June 2010 is/are: a) ☒ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/22)
4) ☐ Interview Summary (PTO-413)
5) ☐ Notice of Informal Patent Application
6) ☒ Other: notice to comply
Paper No(s)/Mail Date _____

DETAILED ACTION

1. Claims 1-10, 12 and 16 are presently pending for examination.

Drawings

2. The objection to the Drawings set forth in the Office Action mailed 02-02-10 is withdrawn in response to Applicant's submission of new corrected drawings in compliance with 37 CFR 1.121(d).

Sequence Information

3. The objection to the specification regarding its failure to comply with the Sequence Rules, as set forth in the prior Office Action, is withdrawn in response to Applicant's submission of a Sequence Listing.

Response to Arguments

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claim Rejections - 35 USC § 112

5. Claims 1-15 remain rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection of claim 16 under 35 USC 112, 2nd ¶ is withdrawn in response to applicant's amendment filed 06-02-2010.
6. Applicant's arguments filed 06-02-2010 have been fully considered but they are not persuasive. Applicants traversed the instant rejection by way of amendment and further on the grounds that "the Examiner should consider that the invention is one that is an intermediate step in an overall process for preparing a protein-polymer." If

Applicant's assertions are correct that the claimed process is merely an intermediate step, then it appears that Applicants admit to claiming an incomplete process.

7. If such is the case, the claims remain rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted steps are: those remaining steps required for producing a protein-polymer complex.

8. Furthermore, the claimed process step appears to teach away from the preamble of the process. The process step appears to be directed to eliminating the polymer is a protein-polymer complex, not to producing a protein-polymer complex.

9. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

10. Claim 16 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. (Written Description).

11. Claim 16 has been amended in the following manner:

16. (currently amended) A method for eliminating a polymer which has ester bound to that is bound to a protein by a thioester of a mercapto group of a cysteine residue of the protein, comprising reacting the protein conjugated with the polymer thereto with a compound having a mercapto group.

12. However, the specification as filed does not teach that the polymer is released or eliminated from the protein upon interaction of an agent having a mercapto group. According to ¶ [0103], the specification teaches that “[i]t is thought that PEG forms an unstable thioester bond with Cys playing an important role in expressing methioninase activity to decrease specific activity in a step of PEG conjugation reaction, but an exchanging reaction occurs by performing DTT treatment, and PEG-rMETase having a recovered SH group is produced.” The passage does not indicate that the PEG polymer is release from methioninase, but that the reaction involves the recovery of a PEG-rMETase.

Claim Rejections - 35 USC § 102

13. The rejection of claims 11, and 13-15 under 35 U.S.C. 102(b) as being anticipated by Tan et al. (WO96/40284A1), is withdrawn in response to Applicant's cancellation of these claims

14. The rejection of claims 11, and 13-15 are rejected under 35 U.S.C. 102(b) as being anticipated by Tan et al. (1998; Protein Expression and Purification, Vol. 12, pages 45-52.), is withdrawn in response to Applicant's cancellation of these claims.

15. The rejection of claim 16 under 35 U.S.C. 102(b) as being anticipated by Zalipsky et al. is withdrawn in response to Applicant's amendment.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janet L. Epps-Smith whose telephone number is 571-272-0757. The examiner can normally be reached on M-F, 10:00 AM through 6:30 PM.

18. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Woitach can be reached on 571-272-0739. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Janet L. Epps-Smith/
Primary Examiner, Art Unit 1633